





1 U.S.C. Section 1367(a).

2 6. This Court has personal jurisdiction over the Defendant, and venue is  
 3 proper in the Southern District of California pursuant to 28 U.S.C. Section 1391(b)-  
 4 (c) because, on information and belief, Defendant has its principal place of business  
 5 in California and this District, Defendant directly and indirectly conducts business  
 6 in California and this District, Defendant has a continuous, systematic, and  
 7 substantial presence within California and this District, Defendant has purposely  
 8 availed itself of conducting business in California, and Defendant has committed  
 9 acts of trademark infringement and unfair competition in California and this  
 10 District, which acts form a substantial part of the events or omissions giving rise to  
 11 Plaintiff's claims. In this regard, Plaintiff is informed and believes, and on that  
 12 basis alleges that Defendant directly and indirectly markets, advertises, promotes,  
 13 offers for sale and has sales of its products and services in California and in this  
 14 District.

### 15 III.

#### 16 **FACTUAL ALLEGATIONS COMMON TO ALL CLAIMS**

#### 17 **Primerus' Longstanding and Exclusive Trademark Rights**

18 7. Primerus is an international society of the world's best small and mid-  
 19 size boutique law firms. Primerus currently consists of approximately 170 member  
 20 law firms (nine of which are located in California) with 2,500 attorneys in 40  
 21 countries that have expertise in hundreds of specialties and subspecialties, including  
 22 a wide variety of financial matters such that many Primerus members routinely  
 23 provide advice on financial matters and services. Through this vast network,  
 24 Primerus serves as a global legal team, whose member firms work together to meet  
 25 the needs of clients seamlessly and efficiently throughout the United States, and  
 26 throughout the world. In addition to serving as a global legal team, Primerus  
 27 produces publications in the field of law, provides continuing legal education  
 28 seminars and conferences, and engages in extensive media advertising to not only

1 market its services and promote the Primerus name, but also to restore honor and  
2 dignity to the legal profession and to help rebuild the public's trust in lawyers and  
3 the judicial system.

4 8. Since at least as early as 1991, Primerus has been using the trademark  
5 PRIMERUS in connection with high quality legal services, which it provides  
6 through a wide variety of disciplines and specialties, including counseling on a  
7 broad array of financial matters and services.

8 9. Primerus offers clients access to the world's finest attorneys by going  
9 to great lengths to seek out, screen, and regularly audit its member firms to make  
10 sure that only the highest-quality law firms who adhere to the Primerus Six Pillars  
11 (Integrity, Excellent Work Product, Reasonable Fees, Continuing Legal Education,  
12 Civility, and Community Service) are entitled to call themselves members of  
13 Primerus.

14 10. To even be eligible for consideration as a member of Primerus, law  
15 firms in the United States must be "AV" rated, which is the highest rating given by  
16 Martindale-Hubbell, the independent peer review rating source that rates lawyers  
17 for their legal ability and ethics. Firms considered for membership who are "AV"  
18 rated then undergo an extensive investigation by Primerus, including attorney  
19 background checks, a review of references from local judges, attorneys, and clients,  
20 and an analysis of a firm's malpractice history. Once this extensive investigation is  
21 completed, an independent accreditation board formed by Primerus has the final  
22 word on whether a firm is admitted to Primerus. Moreover, firms that are admitted  
23 to Primerus are audited every year to ensure that they continue to meet Primerus'  
24 high standards. Primerus utilizes this rigorous screening process so that its clients  
25 know that when they hire a Primerus law firm, they will get excellent representation  
26 and advice.

27 11. As discussed in this Complaint, Primerus' federally-registered  
28 trademarks and common law trademark rights in the Primerus trademarks are

1 collectively referred to as “PRIMERUS” or the “Mark.”

2 12. Only after a law firm has passed the rigorous screening process  
3 established by Primerus, is the law firm accepted into Primerus and granted a  
4 license to use its Mark. This stringent quality control over its members and the  
5 services being offered under the PRIMERUS trademark preserves and protects the  
6 valuable trademark rights of Primerus. These stringent quality control procedures  
7 also ensure that all goods and services bearing, being offered or advertised under, or  
8 that are associated with the PRIMERUS trademark, will be identified by consumers  
9 of legal services as high quality services that emanate from, or are licensed,  
10 sponsored, approved and/or authorized by Primerus.

11 13. Over the years, Primerus has spent a considerable amount of time and  
12 millions of dollars in establishing and promoting the PRIMERUS Mark throughout  
13 the United States and internationally through its website (www.primerus.com),  
14 television advertising, radio advertising, print advertising, brochures, trade shows,  
15 and other means. Likewise, the Mark has been promoted by licensees of Primerus  
16 throughout the United States and internationally on an extensive and frequent basis  
17 in a variety of media, including, without limitation television, radio, and the  
18 Internet.

19 14. The PRIMERUS Mark is inherently distinctive, arbitrary and fanciful.  
20 As a result of the substantial use and promotion by Primerus and its licensees of the  
21 PRIMERUS Mark, the Mark has acquired tremendous goodwill and great value as  
22 a specific identifier of the services provided by Primerus and serves to distinguish  
23 the services provided by Primerus from that of others. As such, the PRIMERUS  
24 Mark has acquired secondary meaning in the minds of relevant members of the  
25 public as a symbol of the high quality of Primerus’ goods, services and goodwill.

26 15. The success, value, and goodwill of the PRIMERUS Mark is reflected  
27 in an article about Primerus that was published by the Wall Street Journal, which  
28 compared Primerus to the “Good Housekeeping Seal of Approval” for law firms.



1 transaction as the starting point of the ongoing support in helping the client reach  
2 their strategic goals.”

3 22. Defendant also claims that it works closely with attorneys by stating  
4 on its website that attorneys “look to Primerrus Financial Services solutions for  
5 their client.”

6 23. At no time has Primerus ever given Defendant a license, permission, or  
7 authority to use or display the PRIMERUS Mark in connection with any of  
8 Defendant’s products or services.

9 24. Without permission or consent from Primerus, Defendant offered for  
10 sale, marketed, and sold its products and services under the name “Primerus  
11 Financial Services.”

12 25. As a result, on February 3, 2014, Primerus’ attorney sent a cease and  
13 desist letter to Defendant via certified mail and email.

14 26. Since Defendant never responded to the cease and desist letter sent by  
15 Primerus’ attorney on February 3, 2014, Primerus’ attorney sent another letter via  
16 certified mail and email to Defendant on February 19, 2014 regarding Defendant’s  
17 improper use of the PRIMERUS Mark.

18 27. Although Defendant never responded to either the February 3, 2014  
19 cease and desist letter, or the February 19, 2014 letter sent by Plaintiff regarding the  
20 improper use of the PRIMERUS Mark, Defendant subsequently changed the  
21 spelling of its business from “Primerus” to “Primerrus.” Similarly, the Defendant  
22 changed its website address to [www.primerrus.com](http://www.primerrus.com).

23 28. Consequently, without the permission or consent of Primerus,  
24 Defendant has been offering for sale, marketing, and selling its products and  
25 services under the name “Primerrus Financial Services.”

26 29. Primerus has not consented to or authorized Defendant to use its  
27 PRIMERUS Mark, nor the Primerus trade, domain, and corporate names for any  
28 products or services.

30. The use by Defendant of a mark that is virtually identical and confusingly similar to Plaintiff's PRIMERUS Mark in connection with Defendant's marketing and sale of its products and services is likely to cause confusion and mistake in the minds of the public and relevant consumers, is likely to damage, tarnish, and dilute Plaintiff's Mark, and tends to and does falsely create the impression that Defendant's services that are offered under the "Primerrus" name originate from or are authorized, sponsored, or approved by Plaintiff when they are not, and there is no association or affiliation between Plaintiff and Defendant whatsoever.

31. Although explicitly advised of Plaintiff's PRIMERUS Mark and trade name, the Defendant has refused to cease doing business under the name "Primerrus." Thus, the activities of Defendant complained of herein constitute willful and intentional infringement of Plaintiff's PRIMERUS trademark, are in total disregard of Plaintiff's rights, have continued despite Defendant's knowledge that the use of Plaintiff's Mark, or a virtually identical imitation thereof, is in direct contravention of Plaintiff's rights.

32. As a direct and proximate result of Defendant's unlawful conduct as set forth above, Plaintiff has suffered, and will continue to suffer, irreparable injury to its PRIMERUS Mark and its Primerus trade, domain and corporate names, as well as irreparable injury to the goodwill and business reputation associated with Plaintiff's PRIMERUS Mark and the Primerus trade, domain and corporate names, which are exclusively associated with a single source – Plaintiff Primerus.

33. Unless Defendant is enjoined and restrained by this Court from engaging in the unlawful conduct described above, Plaintiff will suffer irreparable injury.

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46. Defendant's actions were done with knowledge and/or reckless disregard, and with the intent to cause confusion and to mislead and deceive the public and these statements have actually deceived or have a tendency to deceive a substantial segment of the public.

47. The above acts of the Defendant have injured and damaged Plaintiff.

48. Plaintiff has no adequate remedy at law. Defendant's conduct, as described herein, has caused and, if not enjoined, will continue to cause irreparable damage to Plaintiff. As a result of Defendant's conduct, Plaintiff is entitled to injunctive relief and damages.

49. As a direct and proximate result of Defendant's unlawful conduct, Plaintiff has suffered and is entitled to monetary damages in an amount not yet determined.

50. Defendant's acts were in conscious and willful disregard of Plaintiff's trademark and trade names, and the resulting damage to Plaintiff warrants treble damages and attorneys' fee and costs.

### **THIRD CAUSE OF ACTION**

#### **(UNFAIR BUSINESS PRACTICES – CAL. BUS. & PROF. CODE SECTIONS 17200 *et. seq.*)**

51. Plaintiff incorporates paragraphs 1 through 50 as though the same were fully set forth herein.

52. The above acts and practices of Defendant are likely to mislead the general public and, thereby constitute unfair and fraudulent business practices and unfair, deceptive, untrue, and misleading advertising in violation of California Business and Professions Code Sections 17200 *et. seq.* Defendant's conduct caused injury to Plaintiff resulting in loss of money or property and caused injury in fact to Plaintiff resulting in loss of money or property.

53. Plaintiff is entitled to relief against Defendant, including full restitution and/or disgorgement of all profits and benefits that may have been

1 obtained by Defendant as a result of such unfair, deceptive, and/or fraudulent  
2 business practices.

3 54. As a direct and proximate result of Defendant's unlawful conduct,  
4 Plaintiff has been and will continue to be harmed, injured and/or damaged by  
5 Defendant's wrongful acts, and such harm, injury and/or damage will continue  
6 unless Defendant's conduct is enjoined by this Court.

7 **FOURTH CAUSE OF ACTION**

8 **(TRADEMARK AND TRADE NAME INFRINGEMENT – CAL. BUS.**  
9 **& PROF. CODE SECTIONS 14335 and 14402)**

10 55. Plaintiff incorporates by reference paragraphs 1 through 54 as though  
11 the same were fully set forth herein.

12 56. The above acts and practices of Defendant constitute trademark  
13 infringement in violation of California Business and Professions Code Section  
14 14335 and trade name infringement under California Business and Professions  
15 Code Section 14402. Defendant's conduct caused injury to Plaintiff resulting in  
16 loss of money or property and caused injury in fact to Plaintiff resulting in loss of  
17 money or property.

18 57. Defendant has used and will continue to use the PRIMERUS  
19 designation and trade name and/or a virtually identical and confusingly similar  
20 designation and trade name in order to promote its products, services, and business  
21 for the purpose of enhancing the commercial value of, or selling or soliciting  
22 purchases of, Defendant's counseling and financial advisory products and services.

23 58. As a direct and proximate result of Defendant's unlawful conduct,  
24 Plaintiff has been and will continue to be harmed, injured, and/or damaged by  
25 Defendant's wrongful acts, and such harm, injury and/or damage will continue  
26 unless Defendant's conduct is enjoined by this Court.

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28 ///







1 against Defendant.

2 10. Award Plaintiff pre-judgment interest and post-judgment interest in the  
3 maximum amount permitted by law.

4 11. Award any and all such additional relief in favor of Plaintiff that this  
5 Court deems just and proper or to which Plaintiff may be entitled.

6  
7 DATED: January 29, 2015

GREENBERG GLUSKER FIELDS  
CLAMAN & MACHTINGER LLP

8  
9 By: /s/ Aaron J. Moss  
10 AARON J. MOSS (SBN 190625)

11 LEE T. SILVER  
12 SILVER & VANESSEN, P.C.  
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(*Pro Hac Vice* Application Pending)

13 Attorneys for Plaintiff THE  
14 INTERNATIONAL SOCIETY OF  
15 PRIMERUS LAW FIRMS, LTD.

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# EXHIBIT A

Int. Cls.: 35 and 42

Prior U.S. Cls.: 100 and 101

Reg. No. 1,718,664

**United States Patent and Trademark Office** Registered Sep. 22, 1992

**SERVICE MARK  
PRINCIPAL REGISTER**

**PRIMERUS**

PRIMERUS CORPORATION (MICHIGAN CORPORATION)  
600 FREY BUILDING, 300 OTTAWA N.W.  
GRAND RAPIDS, MI 49503

FOR: PREPARATION AND MEDIA PLACEMENT OF ADVERTISING FOR LAW FIRMS AND LAWYERS; AND LAW FIRM AND LAWYER PRACTICE DEVELOPMENT SERVICES; NAMELY, CLIENT REFERRALS, PUBLIC RELATIONS, MARKETING CONSULTING, AND MARKET RESEARCH, IN CLASS 35 (U.S. CL. 101).

FIRST USE 8-8-1991; IN COMMERCE 8-8-1991.

FOR: ASSOCIATION SERVICES; NAMELY, PROMOTING THE INTERESTS OF LAW FIRMS AND LAWYERS, IN CLASS 42 (U.S. CL. 100).

FIRST USE 8-8-1991; IN COMMERCE 8-8-1991.

SER. NO. 74-235,987, FILED 1-8-1992.

LALITHA MANI, EXAMINING ATTORNEY







